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Applicant(s) : Thomas SONNENREIN et al.
Serial No. : 10/517,740
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For : METHOD AND DEVICE FOR ESTABLISHING A
COMMUNICATION CONNECTION BETWEEN A CONTROL
CENTER AND A TERMINAL
Art Unit : 2617
Examiner : Jamie Michele HOLLIDAY
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**APPELLANTS' REPLY BRIEF
UNDER 37 C.F.R. § 41.41**

SIR :

This Reply Brief is being filed in response to the Examiner's Answer mailed on June 9,
2009.

ARGUMENTS

A. Rejection of Claims 14-22, 26-27, 37, 39 and 41 under 35 U.S.C. § 103(a)

Claims 14-22, 26-27, 37, 39 and 41 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kennedy (US Patent Number 5,734,981) and Tomcik (US Patent Number 6,317,607). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Independent claim 14 recites, in relevant parts, the following: (a) “requesting, by a call by the control center, establishment of a connection to the terminal”; (b) “terminating, by the terminal, the call without accepting the call”; (c) “checking, by the terminal, on the basis of data delivered by a call, whether the call is at least one of intended to initiate a connection to a control center and authorized to initiate a connection with the control center”; and (d) “in response to a determination that the connection to the control center is permitted to be established, automatically establishing, by the terminal, a communication connection to the

control center; and transmitting data via the established communication connection.” It is absolutely clear that claim 14 requires two completely different and separate communication actions: the first action is “a call by the control center,” which is terminated by the terminal without being accepted, and the second action is “a communication connection to the control center” which is established by the terminal if it is determined that “the call is at least one of intended to initiate a connection to a control center and authorized to initiate a connection with the control center.” Independent claims 15-16 and 37, 39 and 41 similarly require terminating the call from the control center without accepting and separately establishing communication between the terminal and the control center if it is determined that “the call is at least one of intended to initiate a connection to a control center and authorized to initiate a connection with the control center.”

On page 4 of the Examiner’s Answer, the Examiner now contends that the claimed limitation of “checking, by the terminal, on the basis of data delivered by the call, whether the call is at least one of intended to initiate a connection to the control center and authorized to initiate a connection with the control center” in claim 14 is taught by Fig. 6; col. 9, l. 30-50; and col. 10, l. 15-17 and 22-24 of Kennedy because Kennedy discloses “receiving the call back message which can automatically initiate a call back using mobile voice communication device 90 . . . , *wherein the processor much ‘check’ the call back message to determine where to call and how to initiate the communication.*” However, the Examiner’s own statement inherently contradicts the conclusion sought to be asserted by the Examiner: the Examiner explicitly concedes that the call back message automatically initiates a call back by the mobile device, which inherently means the call back by the mobile device is not in any way preconditioned on “checking . . . whether the call is at least one of intended to initiate a connection to the control center and authorized to initiate a connection with the control center.” Furthermore, to the extent the Examiner summarily contends, without any support, that “*the processor much ‘check’ the call back message to determine where to call and how to initiate the communication,*” even if one assumed for the sake of argument that this assertion is correct, determining “where to call and how to initiate the communication” simply does not equate to “checking . . . whether the call [by the control center] is at least one of intended to initiate a connection to the control center and authorized to initiate a connection with the control center.”

Independent of the above, Applicants previously argued in the Appeal Brief the following:

To the extent the Examiner is contending that the motivation for the asserted modification is “to allow a wireless device determine if an incoming call is in a selected communication mode before accepting as taught by Tomcik et al. in the system of Kennedy, III et al. in order to successfully deliver call in a communication system” (Final Office Action, p. 5), this contention simply does not make sense since determining “if an incoming call is in a selected communication mode” is completely unrelated to the operation of the system of Kennedy, i.e., successful delivery of a call in Kennedy is not dependent on determining “if an incoming call is in a selected communication mode,” and there is simply no logical reason why one of ordinary skill in the art would add to the operation of Kennedy the step of terminating the call without accepting the call, in combination with coupling calls to complete a call delivery as taught by Kennedy; indeed, the combined steps are completely at odds with one another.

In response to the above-quoted argument presented in the Appeal Brief, the Examiner recites in the Examiner’s Answer the most general, superficial similarities between the teachings of Kennedy and Tomcik as allegedly providing the requisite motivation to combine the teachings of Kennedy and Tomcik in the manner asserted by the Examiner, i.e., the Examiner contends the following: (1) both Kennedy and Tomcik teach call initialization and delivery; (2) both Kennedy and Tomcik explicitly or implicitly discuss coupling calls; (3) both Tomcik and Kennedy explicitly or implicitly discuss a call termination; (4) both Tomcik and Kennedy discuss data and voice communications; and (5) “claimed steps (a), (b) and (c) are not in a conditional and/or ordered relationship.” (Examiner’s Answer, p. 28-29). However, the above-noted general, superficial similarities between Kennedy and Tomcik asserted by the Examiner, e.g., call coupling and call termination, simply do not address the specific technical and logical reasons which lead away from the Examiner’s asserted modification, i.e., the fact that both Kennedy and Tomcik may generally discuss call coupling and call termination simply does not provide any logical reason why one of ordinary skill in the art would add to the operation of Kennedy the step of terminating the call without accepting the call, in combination with coupling calls to complete a call delivery as taught by Kennedy, particularly since the additional step of “terminating the call” simply does not promote the alleged benefit linked to the combination, i.e., “in order to successfully deliver call in a communication system,” and determining “if an incoming call is in a selected communication mode” is completely irrelevant to successful delivery of a call in Kennedy.

To the extent the Examiner contends that “claimed steps (a), (b) and (c) are not in a conditional and/or ordered relationship,” this contention has absolutely no logical connection to whether there exists any motivation to make the specific modification asserted by the Examiner. At best, even if one assumes for the sake of argument that the Examiner is correct in contending that “claimed steps (a), (b) and (c) are not in a conditional and/or ordered relationship,” which is clearly not the case as explained below, the alleged lack of “conditional and/or ordered relationship” does not at all support the Examiner’s asserted modification to add to the operation of Kennedy the step of terminating the call without accepting the call, in combination with coupling calls to complete a call delivery as taught by Kennedy.

Independent of the above, to the extent the Examiner is contending that “claimed steps (a), (b) and (c)” should not be read as being “in a conditional and/or ordered relationship,” this interpretation is clearly incorrect. It is a fundamental rule of claim interpretation that the claims should be given “the broadest reasonable interpretation” that is consistent with the specification and the interpretation that those skilled in the art would reach. (See M.P.E.P. 2111, citing In re Hyatt, 211 F.3d 1367 (Fed. Cir. 2000), and In re Cortright, 165 F.3d 1353 (Fed. Cir. 1999)). In addition, as noted by the Court of Appeals for the Federal Circuit, a claim should not be interpreted to exclude a preferred embodiment. See Primos, Inc. v. Hunter's Specialties, Inc., 451 F.3d 841, 848 (Fed. Cir. 2006). Applying these rules of claim interpretation, claimed steps (a), (b) and (c) in claim 14 should be interpreted as being in a conditional and/or ordered relationship. First, the present specification clearly indicates that the conditional and/or ordered relationship of claimed steps (a), (b) and (c) is central to the disclosed invention, and therefore the Examiner’s asserted interpretation would be contrary to the preferred embodiment disclosed in the present specification. Second, one of ordinary skill in the art would interpret claimed steps (a), (b) and (c) as being in that order, particularly when viewed in light of claimed step (d). In this regard, the plain language of claimed steps (a), (b), (c) and (d), as well as inherent logic, clearly indicates that step (a) is the first step and step (d) is the last step. With respect to the order of steps (b) and (c), it simply doesn’t make sense that one of ordinary skill in the art would interpret the limitations such that the call termination step (b) occurs after the determination of intention to initiate a connection (step (c)), since the final step (d) of establishing a connection is “in response to a determination” made in step (c), and simply terminating the call in step (b) prior to step (d) of establishing a connection would not serve any logical purpose.

Independent of the above, the Examiner's asserted modification of Kennedy to incorporate the step of "terminating, by the terminal, the call without accepting the call" would clearly change the principle of operation of the prior art invention being modified (i.e., Kennedy), (see MPEP 2143.01 VI, citing In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959)), or render the prior art invention being modified unsatisfactory for its original intended purpose, (see MPEP 2143.01 V, citing In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), thereby defeating the obviousness conclusion as a matter of law, since the operation of Kennedy is clearly focused on coupling calls and has no logical relationship to rejecting a call as a matter of standard operating procedure. The Examiner has not provided any direct rebuttal to the above-noted arguments regarding the change in the principle of operation and rendering the prior art invention unsatisfactory for its original intended purpose.

On p. 30 of the Examiner's Answer, the "Examiner maintains that Tomecik discloses receiving a page message which is a request for call initialization (call is at least one of intended to initiate a connection to the control center)," but there is simply no basis for this assertion, and the Examiner still does not provide any supporting citation for this assertion.

Independent of the above, the Examiner further contends on p. 31 of the Examiner's Answer that "claim 14 lacks the conditional relationship language wherein a communication connection to the control center is subsequent to the call be terminated." However, the Examiner's asserted interpretation, i.e., that the step of "establishing . . . a communication connection to the control center" can occur prior to the step of "terminating . . . the call without accepting the call," is simply absurd: if the communication connection is already established, then it is simply impossible to perform the step of "terminating . . . the call without accepting the call." Accordingly, it is inherent that the step of "establishing . . . a communication connection to the control center" occurs after the step of "terminating . . . the call without accepting the call," and there is simply no reasonable basis for the Examiner to contend that one of ordinary skill in the art would interpret the claimed features in the manner asserted by the Examiner.

In addition to the above, the Examiner presents a completely new argument, i.e., Kennedy suggests "a termination, not explicitly, wherein the call back message, when it includes a direct number to a caller, is disconnected (see fig. 6)." (Examiner's Answer, p. 32). However, it is readily apparent that the Examiner's argument is irrelevant to the claimed feature at hand: Kennedy clearly states that "[i]f the call back message . . . specifies a direct dial number for

caller 36, then platform 18 [Examiner's alleged equivalent of claimed "control center"] disconnects the call at step 256," (col. 14, l. 36-38), which is completely contrary to the claimed limitation of "terminating, by the terminal, the call without accepting the call." To the extent the Examiner continues the argument by stating that the "call back message, in and of itself is not a connection, but rather the delivery of the call back message would read on the argued 'first connection,' and the actual call back to the platform from the mobile unit read on the argued second connection." (Examiner's Answer, p. 32), this argument simply does not make any sense, particularly since Kennedy does not disclose "terminating, by the terminal, the call without accepting the call" under any circumstance. In this regard, claim 14 clearly recites that "the call" which includes the data for the checking is terminated ("terminating, by the terminal, the call without accepting the call"), and a separate connection is established in response to a determination that the connection to the control center is permitted to be established ("automatically establishing, by the terminal, a communication connection to the control center; and transmitting data via the established communication connection"). In contrast, the call back message from platform 18 and the actual call back to the platform 18 by the mobile unit 12 in response to the call back message of Kennedy are part of the same call, rather than a connection separate from the call itself as provided for in claim 14. The call back messages of Kennedy are transmitted by a platform 18 to a mobile unit 12 when a caller 36 calls the mobile unit 12. If the mobile unit 12 decides to call the platform 18, the call from the caller 36 and the call from the mobile unit 12 are coupled to complete call delivery. (See Kennedy, column 8, lines 22 to 32; col. 14, l. 36-61).

For at least the foregoing reasons, independent claims 14-16 and 37, 39 and 41, as well as dependent claims 17-22 and 26-27, are not rendered obvious by the combination of Kennedy and Tomcik. Reversal of the obviousness rejection is requested.

B. Rejection of Claims 23-25 and 28-30 under 35 U.S.C. § 103(a)

Claims 23-25 and 28-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kennedy, Tomcik and Oka (U.S. Patent No. 6,091,945).

Claims 23-25 and 28-30 ultimately depend on claims 14-16. For the reasons discussed above in connection with claims 14-16, the overall teachings of Kennedy and Tomcik clearly do not render parent claims 14-16 obvious. Furthermore, Oka clearly does not remedy the deficiencies of Kennedy and Tomcik as applied against independent claims 14-16. Therefore,

the overall teachings of Kennedy, Tomcik and Oka cannot render dependent claims 23-25 and 28-30 obvious. Reversal of the obviousness rejection is requested.

C. Rejection of Claims 31, 33-36, 38 and 40 under 35 U.S.C. § 103(a)

Claims 31, 33-36, 38 and 40 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 5,734,981 ("Kennedy III et al.") in view of U.S. Patent No. 6,317,607 "Tomcik et al.") and in further view of U.S. Patent No. 6,856,820 ("Kolls").

Claims 31 and 33-36 ultimately depend on claims 14-16, and independent claims 38 and 40 recite features substantially similar to the features of independent claims 14-16 discussed above. For the reasons discussed above in connection with claims 14-16, the overall teachings of Kennedy and Tomcik clearly do not render parent claims 14-16 obvious. In addition, Kolls clearly fails to remedy the deficiencies of Kennedy and Tomcik as applied against claims 14-16. Therefore, the overall teachings of Kennedy, Tomcik and Kolls cannot render claims 31, 33-36, 38 and 40 obvious. Reversal of the obviousness rejection is requested.

D. Rejection of Claim 32 under 35 U.S.C. § 103(a)

Claim 32 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kennedy, Tomcik, Oka and Kolls.

Claim 32 ultimately depends on claim 15. For the reasons discussed above in connection with claims 14-16, the overall teachings of Kennedy and Tomcik clearly do not render parent claim 15 obvious. In addition, Oka and Kolls clearly fail to remedy the deficiencies of Kennedy and Tomcik as applied against parent claim 15. Therefore, the overall teachings of Kennedy, Tomcik, Oka and Kolls cannot render claim 32 obvious. Reversal of the obviousness rejection is requested.

E. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the final rejections of claims 14-41 should be reversed.

Respectfully submitted,

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